

Response to Office Action
SN 10/772,738
Customer No. 33354

REMARKS

A. Status of the Claims

Claims 2-18 are pending. Claims 6 and 18 have been allowed. Claims 2, 11 and 17 are amended herein.

B. Allowable Subject Matter

Applicants thank the Examiner for indicating that claims 6 and 18 are allowable as written.

C. § 103 Rejections Citing Angeley et al. and Hofmann

1. No *Prima Facie* Case of Obviousness

The Examiner has rejected claims 2, 3-5, 7-10, 12 and 17 under 35 USC §103(a) as being obvious when U.S. Patent Application Publication US 2002/0138119 to Angeley et al. (Angeley) is viewed with U.S. Patent No. 4,984,892 to Hofmann (Hofmann).

The Examiner asserts that it would have been obvious to use the single optical element of Hofmann in the invention of Angeley as an alternative scanning means to achieve hemispherical coverage. Applicants have carefully reviewed Angeley, Hofmann, and the MPEP's standards for setting forth a *prima facie* case of obviousness and respectfully disagree.

The MPEP requires three basic criteria to properly establish a *prima facie* case of obviousness. *MPEP* §2143. First, there must be some suggestion or motivation, either in the references themselves or the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings. *Id.* Second, there must be a reasonable expectation of success. *Id.* Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *Id.*

BEST AVAILABLE COPY

Response to Office Action
SN 10/772,738
Customer No. 33354

Angeley is an active scanning device that uses two optical elements to deflect a laser beam forward of the scanning head. Hofmann, however, does not deflect a laser beam forward. Hofmann is a passive sensing system that receives incoming energy and does not disclose emitting any energy (laser or otherwise) itself. While Hofmann discloses scanning a space, it does not emit a laser beam or any other type of energy to do so. Therefore, there is no motivation to combine Angeley and Hofmann.

The Examiner's bare recitation of Okazaki and Onimaru do not suggest that combining active scanning and passive devices is knowledge generally available to one of ordinary skill in the art.

Therefore, there is no suggestion or motivation, either in the references themselves or the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings and consequently, a prima facie case of obviousness has not been met. The Examiner is respectfully requested to withdraw this rejection.

2. The References Teach Away From the Examiner's Combination

Further, it is improper to combine references where the references explicitly teach away from the combination. *MPEP* §2145 (X)(D)(3) citing *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir 1983).

As to independent claims 2 and 17, The Examiner argues that it would be obvious to combine the single optical element disclosed by Hofmann to scan the entire hemisphere with the scanning device disclosed by Angeley. However, aside from the fact Hofmann does not disclose emitted laser energy to scan, Hofmann states that its single optical element cannot effectively scan (even passively) the entire hemisphere. Specifically, Hofmann recites that "If $\phi = 90^\circ$, however, the rotational speeds for α and ϕ would become infinitely large... Thus, in practice, a certain angular space near 90° cannot be scanned." See column 6,

Response to Office Action
SN 10/772,738
Customer No. 33354

lines 24-28, emphasis added. Hofmann goes on to state "... it is difficult to scan the entire elevational angular range of up to 90° with but one deflection element." See column 6, lines 31-32, emphasis added. Hoffman explains that several sensors must be used to scan a hemispherical space. See column 6, lines 39-45, Figs 2 and 5.

Therefore, Hofmann explicitly teaches against the use of a single optical element to scan the entire hemisphere. The references teach away from each other and do not set forth a prima facie case of obviousness. The Examiner is respectfully requested to withdraw this rejection.

As to claims 3-5, 7-10 and 12, the Examiner is also respectfully requested to withdraw the rejections of these claims based on their dependency on allowable base claims 2 and 17.

D. § 103 Rejections Citing Angeley, Hofmann, and Miller

The Examiner has rejected claims 11 and 13-16 as being obvious when Angeley is viewed with Hofmann and in further view of U.S. Patent 5,879,376 to Miller (Miller). Claims 11 and 13-16 depend from claim 2 which is believed to be allowable as written. Therefore, claims 11 and 13-16 are also believed to be allowable based on their dependency on an allowable base claim and the Examiner is respectfully requested to withdraw these rejections as well.

(rest of page left blank intentionally)

BEST AVAILABLE COPY

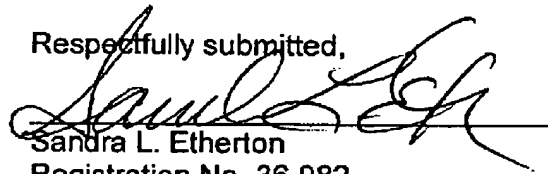
Response to Office Action
SN 10/772,738
Customer No. 33354

CONCLUSION

Applicants respectfully submit that all objections and rejections have been traversed, and that the application is in form for issuance. If the Examiner has any suggestions or comments that would place the application in even better form for allowance, he is invited to call Applicants' representative, Damon Ashcraft at 602-681-3331.

2/13/06
Dated

Respectfully submitted,



Sandra L. Etherton
Registration No. 36,982
J. Damon Ashcraft
Registration No. 51,024

Etherton Law Group, LLC
Customer No. 33354
5555 E. Van Buren St. Suite 100
Phoenix, Arizona 85008-3422
Tel: 602-681-3331
Fax: 602-681-3339

BEST AVAILABLE COPY